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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,690	03/29/2004	J. Christopher Marmo	D-4109	1370
33197	7590	05/26/2006	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			NUTTER, NATHAN M	
4 VENTURE, SUITE 300			ART UNIT	
IRVINE, CA 92618			PAPER NUMBER	

1711

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/811,690

Applicant(s)

MARMO, J. CHRISTOPHER

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6,7,10,11,14,16-19,22,24,26-28,30,32-36,38,40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,10,11,14,16-19,22,24,26-28,30,32-36,38,40 and 42-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09-04, 03-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4, 7, 10, 19, 22, 24 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The recitation in claims 7 and 24 of "the contact lens body has an increased modulus relative to an identical lens body in which the water soluble polymer component is replaced with water" relates to the recited "(p)hysical blends" being defined by reference to a desirable characteristic of property. To determine what the effect that is recited as an "increased modulus of the contact lens body" would require the undue burden of experimentation.

The recitation in claims 10 and 27 of "the contact lens is configured so that at least a portion of the water soluble polymer component leaves the contact lens body" renders these claims as vague since there is no recited "configuration." To determine what such a configuration would entail would require the undue burden of experimentation.

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The recitation in claim 19 of “the container is structured to hold the contact lens...” is not enabled since the structure is not shown. The burden of undue experimentation would be required to determine what is intended by the claim.

In claims 4 and 22, the recitation of “the water soluble polymer component in the contact lens is derived from a diluent material” does not provide sufficient details to determine what is included or how it is made. The claim is meaningless to an artisan without the burden of undue experimentation to determine the meaning thereof.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claims 7 and 24 of “the contact lens body has an increased modulus relative to an identical lens body in which the water soluble polymer component is replaced with water” relates to the recited “(p)hysical blends” being defined by reference to a desirable characteristic of property. These properties would be present in identical compositions as inherent characteristics. Applicants have not recited any parameters in the claims that would suggest or teach otherwise. As such, any composition blend having the recited constituents would be deemed to possess theses same properties and characteristics. Nothing is recited to indicate otherwise. Note *In re*

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Spada, 911 F 2<sup>nd</sup> 705, 709 15 USPQ 1655, 1658 which held that “(w)hen the claimed compositions are not novel, they are not rendered patentable by recitation of properties whether or not these properties are shown or suggested.” Further, a patentee does not have to recognize a characteristic for that characteristic to be there.

The recitation in claims 10 and 27 of “the contact lens is configured so that at least a portion of the water soluble polymer component leaves the contact lens body” renders these claims as vague since there is no recited “configuration.” It is not clear as to what this may embrace.

In claims 16, 32 and 42, the several recitations of “such as” and “and the like” render those claims as vague and confusing because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

The recitation in claim 19 of “the container is structured to hold the contact lens...” renders the claim as vague and confusing since the structure is not recited.

In claims 4 and 22, the recitation of “the water soluble polymer component in the contact lens is derived from a diluent material” renders the claim as vague since there is nothing recited to indicate what the metes and bounds of this expression might embrace.

The recitation of “placing the lens body in a packaging container” is not clear since it is not recited how this placement occurs. Any product for sale must be properly packaged as standard practice. As such, the claim and those dependent thereon, are rendered vague and confusing.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Hu et al (US 2001/0044482), newly cited.

The reference to Hu et al shows the contemplated invention at the Abstract, paragraphs [0017]-[0019], [0022], [0029], [0032]-[0035], [0047]-[0048], [0051] and the many Examples.

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (US 4,123,408), newly cited.

Note the Abstract, column 2 (lines 38-55), column 3 (line 64) to column 6 (line 63), the Example at columns 8 and 9 and the claims.

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (US 4,462,665), newly cited.

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Note the Abstract, column 2 (line 1) to column 4 (line 49), the many Examples and the claims.

Claims 1-3, 10, 16-19 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (US 6,008,170), newly cited.

Note the Abstract, the paragraph bridging column 3 to column 4, column 6 (lines 45-61), the Examples and claims.

Claims 1-3, 10, 16-19 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Salpekar et al (US 6,440,366), newly cited.

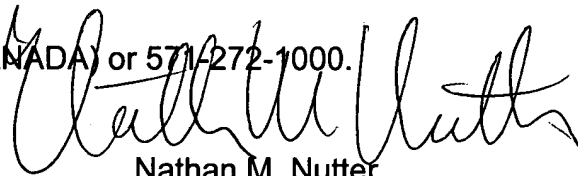
Note the Abstract, column 3 (line 53) to column 7 (line 57), the Examples and the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

24 may 2006